

No. 15,855

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT
SYSTEMS, INC.,

Appellants,

vs.

SIDNEY S. RUBALOFF and ABRAHAM M. GROSS, indi-
vidually and doing business as CHECK-A-MATIC Co.,

Appellees.

WM. T. ALVARADO SALES CO., and SPEE-DEE CHECKOUT
SYSTEMS, INC.,

Appellants,

vs.

DU-MORE FIXTURE CO., INC.,

Appellee.

BRIEF FOR APPELLEE CHECK-A-MATIC.

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BRIEF FOR APPELLEE CHECK-A-MATIC.

Introductory and Summary.

This defendant concurs in appellant's statement of Jurisdiction and Statement of the Case, with the exception of the final paragraph of the latter. The facts of record adequately support the finding of invalidity, and, in addition, will fully support a finding of non-infringement.

The District Court has found that the George patent for a grocery store check stand embodying a support for a cash register, a turntable type conveyor for moving a customer's purchases up alongside the register, and a discharge counter onto which the purchases are moved after being checked, is an unpatentable aggregation of components the functions of which are not different from the functions of such components as disclosed in the prior art; that there is no new relationship, coaction or surprising result in such aggregation; and that the alleged invention, as it differs from the prior art, was obvious to a person of ordinary skill in the art; and has concluded that the four claims sued upon, are invalid for lack of invention.

It will be shown that the alleged errors do not exist.

Numerous errors and fallacies do exist in appellant's argument, and will be pointed out herein in due course. It will be shown that while George may have been the first to utilize the well known turntable type conveyor for food articles, for conveying such articles alongside a cash register in a grocery store check stand, such use of the turntable conveyor was never recognized as an invention by the U. S. Patent Office, and the patent in suit does not embrace all check stands utilizing a turntable for conveying grocery articles to the side of a cash register for checking and transfer to a discharge counter, but is restricted to specific features of *arrangement* such as (a) the register support (or some means) being arranged so as to form a *stop* for articles on the turntable; and (b) the discharge counter being arranged to extend *as a continuation* from the periphery of the turntable.

The following additional points are developed in this brief:

Briefly, the accused Check-A-Matic stands each comprises a register support, a turntable type conveyor for moving articles along the left side of the support, a discharge throat, an article guide for deflecting the turntable-borne articles into the throat, and a bagging counter on which the articles are placed after being checked.

In each of the check stands made and sold by the defendant Check-A-Matic, infringement is avoided by the omission of one or more of the above noted restrictive features of arrangement in the patent in suit; in each instance the discharge counter is located at a substantial distance from the turntable and does not extend as a continuation from its periphery; in neither the FD-5 or the C-3 check stand, is there any means to stop articles on the turntable, but instead, a guide which allows continued movement of the articles while redirecting them to a discharge throat beyond the periphery of the turntable, following the teaching of the prior art; and in the FD-5 check stand the register support is arranged outside the periphery of the turntable and is not positioned over the turntable.

The alleged invention, which appellant (ignoring the restrictions referred to above) now urges is covered by the patent, in substance would be no more than the simple substitution of one type of article conveyor for another type of motor driven, switch controlled conveyor for advancing a customer's purchases alongside a cash register in a grocery store check stand having a discharge counter on which the articles can be sacked after they have been checked. Such a substitution did not require

the exercise of invention over the prior art, which disclosed (a) that the concept of using a motor driven turntable for moving groceries up to a check-out station in a grocery store, was an old one, and (b) that the particular type of turntable and guide arm for deflecting food items outwardly from a circular path off the turntable and onto a discharge surface, is an old concept in the food packaging industry prior to the George invention.

The discharge counter of the patent in suit bears the same relation to the turntable conveyor as that existing between the discharge counter and the belt type conveyor of the prior art checkstands, and therefore, under the ruling of the United States Supreme Court in the *A. & P.* case hereinafter referred to, the patent is invalid for over-claiming the alleged invention, *i.e.*, in again claiming the discharge counter in combination with the motor driven conveyor and register support, which George had no right to do.

The Patent in Suit Is a Narrow Patent.

The General Arrangement of Checkstand Components Is the Same in the Patent in Suit as in the Prior Art.

The chief components of a modern check stand are: (a) a support for a cash register; (b) a motor driven conveyor onto which purchased items can be unloaded and by which the items are transported alongside the cash register (the left side of the register as it is faced by the checker) where the checker can grasp the items with the left hand, register the price with the right hand, and move the items rearwardly to (c) a discharge counter (sacking counter) extending rearwardly from the discharge end of the conveyor.

This general arrangement exists not only in the patent in suit and in the allegedly infringing Check-A-Matic and Du-More check stands; it also exists in the early Check-A-Matic check stand [Check-A-Matic Ex. D, R. 301] which appellants have admitted does not infringe the patent in suit, and it also exists in the belt type check stands as illustrated in the Bradley patent No. 2,317,438 and in Du-More Exhibit C [R. 404].

The Bradley patent discloses in Figures 10 and 11, a modification of the check stand shown in his Figure 1. By relating the fragmentary showing in Figure 10 to Figure 1 and to the Bradley specifications (column 2, page 3, line 58 through line 39, column 1, page 4) there is disclosed a check stand as illustrated in Check-A-Matic Exhibit E-4 [R. 311] which embodies a switch controlled, motor driven endless belt conveyor arranged to move groceries from a loading point at its forward end, alongside a register support to a checking point adjacent the left side of the register as faced by the checker, together with a discharge counter onto which the checker transfers the articles after checking.

The Placing of a Turntable in a Super Market Checkout Counter Is Not the Patented George Invention.

Alleged error No. 1: that the Court failed to recognize and take into account the admitted novelty of the patented device.

Appellants place great emphasis upon the fact that the patentee George was the first to use a turntable in a check stand for self service stores. But this is not the George patented invention, and the contention that the trial court failed to recognize and account for this fact

is without foundation. On the contrary, at the end of the trial, the Court himself raised this point [R. 240].

“The Court: I assume, and I don’t think there is any controversy, that the plaintiff here is the first one that used a turntable in a checkout counter.” (to which counsel agreed).

Clearly this point was firmly fixed in the mind of the Court and considered and taken into account in reaching the decision appealed from.

By Appellant’s Own Concession, the Patent Does Not Dominate the Use of the Turntable as a Receiving Conveyor in a Supermarket Check Stand.

Appellant’s counsel, in a letter written September 29, 1953, to local counsel Fred H. Miller [Check-A-Matic Ex. B—R. 304] stated in part:

“I am in agreement with Mr. Latta that the structure disclosed in the Check-O-Matic circular does not infringe the George patent.”

It has been stipulated [R. 39] that Check-A-Matic Exhibit D [R. 307, 308] is a copy of the circular referred to in the letter Exhibit B.

Referring to the cut shown in the lower right hand corner of the second page of Exhibit D, this early Check-A-Matic stand had a turntable receiving counter, a register stand of approximately the same shape as the FD-5 stand, in the same position, a bar switch for stopping rotation of the turntable (which also corresponds broadly to the guide arm of the FD-5) a discharge throat (labelled “Accuracy bridge” in the cut) extending from substantially the same point as the discharge throat of the accused Check-A-Matic stands but for a greater distance, and

finally, a revolving sacking table, corresponding broadly to the sacking counter of the accused stands. Thus the essential elements of the type of check stand involved in this litigation are present in the stand which appellants have admitted is not an infringement, namely, the turntable conveyor, the register support panel beneath which the conveyor revolves, the guide arm, the discharge throat and the packing table.

Clearly, by the appellant's own admission, the placing of a turntable in a checkout stand is not the patented George invention, *i.e.*, is not broadly dominated by the patent.

File Wrapper Estoppel Restricts the Patent in Suit.

By file wrapper estoppel, appellant is estopped to contend that the patent in suit broadly dominates the broad combination of turntable receiving counter, register stand disposed above a quadrant of the turntable, and discharge counter. A claim for this combination was rejected by the Patent Office on the ground that it did not represent an invention over the Bradley, Price and Wilcox patents, and this claim was surrendered by George in favor of one of the restricted claims of the patent. This matter is dealt with more in detail herein in the section dealing with the question of infringement.

Restrictive Features of Claims in Suit.

In addition to the three main components referred to above, the patented check stand embodies (d) a stop (recess 29 in left margin of register support panel) for stopping articles on the turntable; (e) conformity of the forward end of the discharge counter to the periphery of the turntable; (f) extension of the discharge counter as a continuation of the turntable; (g) the inner edge of

the turntable being concavely arcuate with respect to the support panel; (h) a guard ring around the exposed edge of the turntable and extending inwardly over the outer edge of the discharge counter to direct items toward the stop; (i) an electric motor for driving the turntable; and (j) a control (switch) for the motor.

Features (d), (e) and (f) constitute material limitations in the claims of the patent in suit. They can not be ignored.

The Prior Art Discloses All Essential Components of the Patented Check Stand.

Alleged error 12A—that there is no evidence to support finding 7 that each of the individual components of the claimed invention were well known in the prior art.

This contention can be quickly answered. The evidence includes the prior patents included in Du-More Exhibit C, attention being called particularly to the following patents disclosing the components indicated. Since these patents are discussed in detail elsewhere in this Brief, they are commented on only briefly at this point:

Bradley 2,317,438—the general combination and arrangement of essential components including the conveyor, a drive motor, a control therefor, a register support, a stop and a discharge or sacking table.

Price 2,268,897 [R. 391]—showing the combination of turntable conveyor 50, discharge throat 58, and generally radial guide arm 59 for guiding packaged food items off the turntable onto the discharge throat after moving arcuately around the turntable from a loading inlet 57. According to appellant's contentions as to the guide parts of the accused Check-A-Matic stands (which appellees dispute), the Price guide arm 59 would constitute a

“stop”, since, instead of allowing the articles to rotate repeatedly around the table, it directs them off the table into the discharge throat 58.

Florence 1,400,948 [R. 352]—disclosing *the use of a turntable 12 in a self service store* for conveying groceries from a loading point in the back of the store to several checkout points (arcuate tables 6) where a customer may pick up items from the turntable, place them in a basket and carry them to an adjacent cashier’s desk 35 for checking and payment.

Tench 765,298 [R. 325], disclosing a turntable conveyor A and a discharge throat D’ conformed to the arcuate periphery of the turntable.

Muse 2,237,080 [R. 387] disclosing the general combination of receiving conveyor 7, register support surface 21 at the right side thereof, and sacking counter 5 extending rearwardly from the discharge end of the conveyor and having a margin 19 that is curved arcuately rearwardly and laterally, similarly to the sacking counters of the accused Check-A-Matic stands.

Clearly, there is ample evidence supporting finding 7, and this contention of error has no merit.

Operation of Check Stand of Patent in Suit Is Essentially the Same as in the Prior Art.

Alleged error No. 4—that the Court failed to take into account the admitted utility and *allegedly improved action* of the patented device.

Appellees do not deny that the check stand is useful. As to allegedly improved action, however, the operation described on page 12 of Appellant’s Brief is as applicable to the prior art belt type check stand as to the turntable type stands.

In the use of the Bradley stand, for example, the customer approaches a loading position at the front end of the check stand, and an attendant places his articles on the conveyor on the side of the belt which will pass close to the register (note the loading position 11 on the register side of the conveyor, and the description in lines 21-24, col. 1, page 4 of Bradley, relating to his Figures 10, 11). The checker, actuating a control to operate an electric motor which drives the conveyor, causes the articles to be moved by the conveyor to the left side of the register. The customer may place additional articles on the conveyor at the loading position in the area left vacant by movement of the articles toward the register. The checker may pick up the articles while moving alongside the register, or, if congestion occurs, may stop the movement of the conveyor or may allow the articles to be arrested by a stop at the rear end of the belt. In each instance the articles are presented within easy reach near the cash register, are checked by the checker, using his right hand to operate the register, and are moved by the checker, using his left hand, rearwardly to the sacking or "discharge" counter.

The foregoing description of operation, as applied to the Bradley check stand, uses, in essence, appellant's own words employed in describing the operation of the check stand of the patent in suit.

Allegedly Novel Results and Advantages.

Alleged error No. 5—that the trial court failed to take into account the fact that the overall result or function of the patented device is more than the sum of the functions of its several parts, etc.

The following comparison of the similar results obtained in the patented and Bradley check stands clearly shows that this contention of error is without merit.

The Allegedly Improved Result of Bringing Articles Close to the Register Is Fully Anticipated by Bradley.

Appellants, by reference to Plaintiff's Exhibit 8 [R. 261] emphasize the alleged novelty and improved result in the operation of the turntable in bringing the customer's purchases to a point closely alongside the cash register. It is contended that the customer will tend to place his purchases on that side of the conveyor which is nearest to him, that such articles traveling on the belt type conveyor will go outside the normal line of vision, and that it would be easier for the checker to get at the articles if they were traveling on the inside of the belt.

But this is exactly what is disclosed in the Bradley patent, which teaches the unloading of the customer purchases from the shopper's cart onto the receiving table at the unloading station 11 *which is on the inner side of the belt*, so that the articles as thus deposited on the nearer side of the belt will move in a path *closely adjacent the register*, exactly to the point which appellant has emphasized as being the point of easiest reach for the checker, and fully within the range of the checker's vision.

The Bradley patent completely refutes the contention that the turntable of the patent in suit will attain an improved result in bringing the customer's articles more fully within the checker's vision or more convenient to the checker's reach.

The Alleged Novel Result Is Inconsequential.

In any event, the allegedly improved and novel result of bringing the articles closely adjacent the cash register is inconsequential, for the following reasons:

It is common practice for checkers to reach for articles on the turntable before they arrive at a point of maximum closeness to the register. The witness Sellers, who had observed the operation of turntable check stands, in response to the question of where the checker usually picks up a package, replied [R. 198].

“A. Well, that depends on a number of things, how many articles are upon the turntable and their size, but it has been my observation that in the usual event the articles are not too concentrated, and she tends to take them from the turntable before they reach a stop position * * *”.

The plaintiff's witness, Mrs. Kenney, demonstrating a check stand before the Court, reached for articles on the turntable and testified that this was her habit [R. 60].

“Q. You had to reach a substantial distance across the turntable to pick that up. A. That is my habit. I check that way.”

A Checker Can Reach Items on a Belt Conveyor Without Difficulty.

Plaintiff's witness McNeil admitted that the checker can reach articles on a belt conveyor [R. 104] and that the majority of belt conveyors do not exceed 18 inches in width [R. 109]. Plaintiff's witness Alvarado testified (with respect to a checkstand utilizing a belt conveyor in its discharge counter) that in operating this check stand the checker would remove articles from the turntable, weigh them and then slide them across 26 inches to the discharge counter belt [R. 97, 98].

If a checker can reach a belt 26 inches away, she will have no difficulty reaching items on a belt 18 inches in width. Clearly, it is inconsequential, from the standpoint of the ability of the checker to reach the articles approaching her on the conveyor, whether the conveyor is of the turntable type or the linear belt type.

As to the alleged advantage of having the approaching articles on the conveyor clearly within the checker's view, even though we assume that the checker holds her head rigidly in a fixed position with her line of vision substantially as indicated in Plaintiff's Exhibit 8, it is apparent that the articles, reaching a position approximately opposite the center of the cash register where the checker customarily reaches to pick them up, will still be within the full range of vision of the checker substantially as fully in the case of the belt type conveyor as in the case of the turntable. But obviously, the checker will not maintain her head in a rigid position. Plaintiff's witness Kenney [R. 59] testified:

"Q. You don't look directly in front of you, you don't face head on into the cash register at all times. You were looking off to your left, isn't that correct?

A. You have to look both places when you are checking."

Alleged error No. 3—that the trial court failed to take into account the alleged uncontroverted evidence of novel coercion between the elements of the patented device.

The foregoing comparison of operation of the George and Bradley check stands indicates that the coercion between the elements of the patented device is essentially the same as that existing in the prior art. To fully answer the appellant's contention however, the various as-

sertions on pages 13 and 14 of Appellant's Brief will be tested against the prior art:

The Bradley conveyor belt functions to receive articles at a point remote from the checker, and to advance the articles to the same convenient checking position directly alongside the register, and then travels under itself to the front of the stand to receive additional articles.

The Bradley register panel supports the register at the right side of the active conveying area of the belt (as the support panel of the patent in suit supports the register at the right side of the active conveying area of the turntable) with the rear edge of the register close to the rearmost part of the conveyor belt so that the checker can stand within easy arm's reach of articles advanced to the stop by the conveyor belt. As admitted by appellant, the use of the left edge of the register to function as the stop, is not required, and a separate stop plate 83' of Bradley's Figure 10, actually is mounted across the conveyor belt at its rear end (the corresponding part in Bradley's Figure 2, "ramp 32" is described as having a stop function).

The discharge counter 9 of Bradley performs the function of receiving articles advanced thereto, and coacts with the conveyor belt by being conformed at its forward end to the straight transverse shape of the rear end of the active conveying area of the belt.

Bradley's discharge counter coacts with the register support panel to the same extent as in the patent in suit, by being positioned closely adjacent the rear corner of the register panel sufficiently to be within the normal swinging arm's reach of the checker while moving checked items rearwardly, and so that there is a con-

tinuous supporting surface from the stop to the discharge counter. If the checker chooses to do so, the articles can be pushed or swept from the checking position onto the discharge counter over the plate 83' of Figure 10 with essentially the same ease that articles can be transferred over the scale platform of any of the accused check stands.

The plate 83' of Bradley's Figure 10 will function essentially as a stop (to the same extent as there is a stop function in the *discharge throat* of the accused Check-A-Matic check stands) since any article pushed off the conveyor belt onto the plate 83' will stop its rearward travel. Articles with flat bottoms and sharp corners would be stopped by the edge of the plate 83'. This stop coacts with all three of the other components, namely the conveyor, the register support and the discharge counter in that its position is such as to interrupt the advancing motion of the articles close to the side of the cash register and immediately adjacent the discharge counter. When located near or against the stop, all articles are in easy reach of the checker and can be easily viewed by turning her head sideways.

Any difference between the coaction of parts in the patent in suit and in the Bradley check stand is inconsequential and of no patentable importance.

Appellant's Contention That Because the Discharge Counter Is Conformed at Its Forward End to the Circular Shape of the Receiving Table, Such Constitutes Novel Coaction.

The patent in suit discloses, in the counter 5, a surface which *extends continuously from* the surface of turntable 6. The patent advances the theory that this makes it possible for the checker to slide articles off the turn-

table and to the rear end of the counter 5 by a continuous arcuate sweeping movement of the left arm, pivoting around a vertical axis. Actually, this continuous arcuate sweeping sliding movement is not normally practiced in the operation of modern check stands. In all of the accused Check-A-Matic stands (as well as in stands made by others including appellee Du-More and appellant Speed-Dee) a gap wide enough to receive a weighing scale intervenes between the discharge area of the turntable and the sacking counter, and as has been pointed out, it is customary practice for the checker to pick up the articles, check them and place them on the weighing scale or on the sacking counter depending on whether weighing is required.

The small area outlet throat in the accused Check-A-Matic stands, which (rather than the large rectangular counter which actually receives the checked articles) appellant labels "discharge counter" in each of the charts shown on pages II through IX of appellant's Appendix to Brief, is simply the well known outlet throat of a conventional turntable conveyor as disclosed at 58 in Price patent No. 2,268,897, at 60 in the Wilcox patent No. 1,664,055, at 3 in the Hildenbrand patent No. 1,090,713, and at D' in the Tench patent. Tench discloses full conformity of the discharge throat surface to the arcuate contour of the turntable (note Fig. 2).

Insofar as the discharge throat is concerned, if it be regarded as corresponding to the patented discharge counter (which it does not) the coaction between the rotating turntable and the discharge throat is precisely the same as in the Tench patent, the Price patent, and the others noted.

Alleged error 12C—that there is no evidence to support finding 9 that the functions of the components of the invention are no different from those of the prior art and that there is no new relationship and coaction between the components.

It is clear from the foregoing that there is no merit to the appellant's contention, and that this finding is amply supported by the evidence.

The Patent in Suit Is Invalid as an Unpatentable Aggregation.

Appellant's Contention 12B—That There "Is No Evidence to Support Finding 8 That Each Claim Is a Non-patentable Aggregation, Makes No Improvement in the Art and Provides No (New) Function or Interaction of Parts or Novel and Unexpected Consequences."

From the foregoing comparison of operation of the patented and prior art check stands, it is apparent that there is no novel coaction whatever between the conveyor and register support portions of the patented check stand and the discharge or sacking counter thereof. The coaction between these sections of the check stand is in each instance exactly the same. The sacking counter is located directly behind the delivery area of the conveyor and to the rear of the checker's position, in a convenient position for rearward transfer of the checked articles. Beyond that, there is no coaction.

The discharge counter of the patent in suit performs exactly the same function as the sacking counter of the Bradley, Turnham and Muse patents. The register stand, in its relationship to the discharge counter, performs exactly the same function in each instance, *i.e.*, it supports a register at the right side of the operative conveyor

area. The conveyor of the Bradley patent performs the same function in relation to the register stand and sacking counter as does the turntable conveyor of the George patent, *i.e.*, it conveys grocery articles from a loading point at the forward end of the check stand alongside the left side of the register to an area within easy reach of the checker so that the checker may grasp the articles in the left hand, register them with the right hand, and then transfer them rearwardly onto the sacking counter. The stop in the Bradley patent performs essentially the same function as the stop formed in the left margin of the register stand of the patent in suit. In the event of congestion, it will arrest the conveyor-borne movement of the articles before they pass beyond the checker's reach.

Under these circumstances, the patentee George had no right to claim the discharge counter in combination with the conveyor and register support, thereby arming himself with the means to levy tribute upon the manufacture and sale of the well known sacking counter. The claims in suit are therefore clearly invalid as unpatentable aggregations under the well established decisions of this Court and other Courts including the United States Supreme Court, in the following cases:

Goodman v. Supermold Corporation of California
(C. A. 9, 1939), 21 U. S. P. Q. 188;

Willamette-Hyster Co. v. Pacific Car and Foundry Co. (C. A. 9), 50 U. S. P. Q. 422;

Great A. & P. Tea Co. v. Supermarket Equipment Corporation (U. S. S. Ct.), 340 U. S. 147, 87 U. S. P. Q. 303;

Lincoln Engineering Co. v. Stewart-Warner Corp.
(U. S. S. Ct., 1938), 303 U. S. 545, 37 U. S. P. Q. 1; and many other cases.

Paraphrasing the words of the United States Supreme Court in the *A. & P.* case, in which the Turnham patent was held invalid, the words of the Court, as paraphrased, apply precisely to the present situation, as follows:

“This (discharge or sacking) counter does what a store counter always has done—it supports merchandise at a convenient height while the (sacker places the merchandise in sacks and) the customer makes his purchases and the merchant his sales. The (rotary conveyor) will draw or push goods (upon) it from one place to another, just what any such (conveyor) would do . . . and the guide rail keeps it from falling or sliding off from the (conveyor), as guide rails have ever done. Two and two have been added together, and still they make only four.” (Parenthetical material added).

The Court’s finding 12B that the claims in suit are non-patentable aggregations, is eminently correct in this case and should not be disturbed.

For further discussion of the law relating to aggregation and over-claiming, reference is made to the Brief of the appellee Du-More in this Appeal.

The Patent in Suit Does Not Represent Invention Over the Prior Art.

The Prior Art Is Suggestive of the Patented Combination.

Alleged error No. 2—that the trial court failed to take into account the alleged admitted insufficiency of the prior art to teach or suggest the combination of elements in the patented device.

Appellants, at pages 21 through 23 of their Brief, stress several points in the testimony of appellee’s expert, including:

(a) That where an article is advanced alongside *and past* the cash register, it would not be stopped. This was in reply to a hypothetical question, and out of context, insofar as any application to the Bradley patent is concerned. Obviously, articles are stopped at the end of the active stretch of the conveyor belt of Bradley, and this testimony does not in any manner constitute an admission that the stopping of articles in the general vicinity of the cash register is novel.

(b) The question of whether the Price patent *in itself* suggests the substitution of a rotatable turntable to the belt type or straight counter type check stand as shown in other patents. This question is not determinative of the issue of lack of invention. Although the witness Sellers did not state that he found such a suggestion in the Price patent, or any suggestion of requirement that the articles conveyed be checked or recorded, he did testify that the turntable of Price could be incorporated in the check stands of the Bradley and Turnham patents [R. 180, 181, 189]. And he testified that in the Bradley patent itself is contained the suggestion of the substitution of an industrial type conveyor for the type shown in the Turnham patent [R. 192, 193]; and that in making the substitution of a turntable for the conveyor of Hughes, Bradley or Turnham, that "I would substitute one type of loading area for another" [R. 174]; and that in the prior art there are a number of turntables that are adapted to be incorporated (in the check stands of the prior art) [R. 165, 174].

Within the single disclosure of the Bradley patent there is contained the suggestion of the equivalency of different types of conveyors, including the roller mounted tray

running on tracks (Fig. 2) the industrial roller type conveyor (Fig. 7) and the endless belt type conveyor (Fig. 10) for conveying grocery articles from a loading point alongside a cash register. This teaching in Bradley constitutes, in effect, a teaching that any known conveyor can be utilized in a check stand with its active conveying area extending past the left side of the register. The roller type industrial conveyor of Bradley's Figure 7 and the rotary turntable conveyor of the Price patent are directly in the same class of prior art, and it is a perfectly obvious concept to utilize the Price turntable, from the industrial art of loading food packages in a packing house in lieu of the equally industrial type conveyor shown in Figure 7 of the Bradley patent.

The endless belt type conveyor, as disclosed in the Bradley patent, and the turntable type conveyor, as disclosed in the Price patent, are closely analogous devices. The belt conveyor has an upper stretch which, in the Bradley check stand, moves toward the register and past the left side thereof, and is operative for conveying articles alongside the register. It has a lower stretch which executes a return movement and is inoperative, *i.e.* not utilized for conveying articles.

The well known turntable conveyor likewise has an endless conveying area which, instead of bending around spaced rollers, as in the case of the belt conveyor, bends in an arc around the vertical axis of rotation of the turntable. As in the case of the endless belt conveyor, it has an operative area (mainly on its left side as disclosed in the Price patent) functioning to transport food packages from a remote loading point to a discharge throat 58; and it has an inoperative area (lower right quadrant as viewed in Price's Fig. 1) which passes beneath a guide

arm 59 and beneath other guide parts 65, 66 to return to the loading point. Similarly, in the turntable check stands, the conveyor area has a leftward portion moving toward the checker past the left side of the register from a remote loading point, and an inoperative area (forward right quadrant), which passes beneath other portions of the apparatus (*e.g.* the guide arm in the defendant's FD-5 check stand and returns to the loading point).

The concept of arranging the conveyor so that its inoperative area passes *beneath other parts* of the apparatus in returning to the loading point, is disclosed in the Bradley patent and again in the Price patent. It is obviously a common concept.

The Florence Patent Suggests the Substitution of a Rotary Turntable for Bradley's Belt Conveyor.

It is not even necessary to go outside the self-service store to find this suggestion. The Florence patent suggests the use of a turntable for conveying articles from a loading area of a store to a checkout area where a customer intercepts the articles on the turntable, places them in her basket and carries them to an adjacent cashier's desk. Thus the concept of using a turntable to convey groceries from a loading point to a checkout point is clearly disclosed.

The Florence patent was not cited by the Examiner against the patent in suit. Accordingly, there is no presumption of validity of the patent in suit with respect to the Florence patent.

With respect to the Florence patent appellants argue (App. Br. p. 21) that to interpose a checking device over a Florence table 17 would defeat its purpose, as it would sweep all articles off the table as they were advanced to

the side of such checking device, and concludes that such table would then become useless.

This conclusion is obviously unsound, since *the very purpose of the* guide member of the accused Check-A-Matic check stands is identically that which appellants contend would render the turntable useless, namely, to sweep all articles (except those already picked up by the checker) off the turntable into the discharge throat of the apparatus.

Alleged error No. 7—that the trial court failed to recognize the allegedly admitted fact that appellee's cited prior art did not show anything different from that considered by the Patent Office before allowing the patent.

The record directly contradicts appellant's contention in this respect. Defendant's expert Sellers, after discussing the prior patents to Bradley and Muse and Turnham (not cited by the Patent Examiner) when asked if there were any other patents of record relating to checkout stands, mentioned the Goodrich patent No. 1,071,004 [R. 334] "which could have been incorporated into a checkstand" [R. 164]; dwelt at length upon the Florence patent [R. 165, 166, 167] and then stated that the Turnham patent does show something in addition to Bradley [R. 169].

Since it is a fact that there is additional disclosure in uncited art, the allegation of error No. 7 clearly has no merit.

Alleged error No. 12D—that there is no evidence to support finding No. 10 that the difference between the invention and the prior art was obvious to persons having ordinary skill in the art.

Appellant heavily stresses the alleged failure of the prior art to suggest the location of a turntable with a sector thereof disposed beneath the register stand (App. Br. p. 38) and that all prior check stands have continuous supports that obstruct and prevent the positioning of a turntable partially underneath them, and therefore cannot suggest the positioning of a turntable partially underneath them.

It seems too clear to require argument, that if a skilled mechanic undertook to substitute the Price turntable type of conveyor for the endless belt conveyor of Bradley, that the logical location for the turntable would be in the position shown in Check-A-Matic Exhibit E-5, with its operative area (left half) lined up with the discharge counter; and that certainly it would not require any invention on the part of any mechanic or carpenter to cut a slot in the Bradley check stand beneath the register support in order to receive a sector of the turntable, notwithstanding the lack of any specific disclosure of such a slot in the references.

The Examiner in the Patent Office repeatedly held that the matter of substituting a rotary type conveyor for the Bradley conveyor was not an invention, and in his second rejection, he rejected *all* of claims 1 to 20 on Bradley and Price, as follows:

“Claims 1 to 20 are further rejected as being unpatentable over Bradley taken with Wilcox and Price. * * * it is held that no invention would be involved in replacing the conveyor of Bradley by a rotary turntable type of conveyor, suggested by Wilcox and Price”.

Alleged error No. 9—that the trial court failed to recognize and consider the uncontroverted evidence of commercial success of the patent in suit and the tribute paid to the invention by defendant appellees in copying the device of the patent.

**Commercial Success Is Not Determinative of Invention,
Regardless of Whether the Showing Made by Appellants
Is Regarded as Establishing Commercial Success or Not.**

Commercial success will not validate an invalid patent.

Schick Service, Inc. et al. v. Jones (C. A. 9, March. 18, 1949), 173 F. 2d 969; cert. den. 70 S. Ct. 62, 338 U. S. 819.

Nor will commercial success enlarge the range of equivalents to which a patentee may be entitled.

Crampton Mfg. Co. v. Durable Products Company (D. C. W. D. Mich.), 83 U. S. P. Q. 209.

As to the alleged copying of the invention by defendant-appellees, it is submitted that there has not been any copying of the invention, as will be pointed out in the section of this Brief dealing with non-infringement.

There is no indication that the trial court failed to consider the evidence on commercial success and the evidence relating to alleged infringement.

Alleged error No. 10—that the trial court failed to consider that the patent in suit is presumed to be valid.

The presumption of validity cannot prevail over the anticipatory disclosure of references not cited by the Examiner (*e.g.* the important Florence disclosure of the use of a turntable for checking out groceries) nor can it save a clearly invalid patent regardless of lack of new evidence of invalidity.

(*Kwikset Locks Inc. v. Hillgren* (C. A. 9, 1954), 100 U. S. P. Q. 289, 210 F. 2d 483; *Schreyer v. Chicago Motocoil Corp.* (C. C. A. 7), 48 U. S. P. Q. 618.) This is especially applicable to the defense of invalidity for aggregation. Clearly, there is no basis for the contention that the trial court failed to consider this presumption.

Alleged error No. 11—that the trial court failed to consider that the problem solved by the patent in suit had long been recognized by the trade and that in spite of this no one prior to the patentee had been able to conceive or devise the simple solution thereof as disclosed by the patentee.

It is respectfully submitted in this connection that the patent in suit did not solve any pressing problem, since the prior belt type check stand is still in common use as shown by the evidence of the Du-More belt type commercial check stand and as is apparent in countless supermarkets using the belt type stand. Furthermore, the simple solution of the problem of speeding up grocery checking *was solved* by the general combination of motor driven, switch controlled belt conveyor, register stand and discharge counter exemplified in such belt type check-out stands and shown in the prior Bradley patent. It is Bradley and Turnham who should receive the credit for the advance in the art of checking groceries, rather than the patentee George.

The Accused Check-A-Matic Check Stands Do Not Infringe.

Alleged error No. 8—that the trial court failed to take into account the alleged fact that the accused devices each included all of the elements defined by one or more claims of the patent in suit.

This contention is unsound for the reason that the accused devices do not include all elements of any claim.

The FD-5 Check Stand Clearly Avoids Infringement.

Briefly describing this check stand, referring to Check-A-Matic Exhibit "C" [R. 305] it comprises a turntable conveyor 3 the periphery of which rotates immediately adjacent the concave arcuate forward margin of a register support panel of generally triangular shape disposed outside the periphery of the turntable. This register panel is colored blue in the original Exhibit C attached to interrogatories and appears in dark shading in the copy of the Exhibits bound into the record. A merchandise guide arm 17 extends from a point immediately beneath the leftward corner of the register panel (as faced by the checker) to the center of the turntable on an angle diverging with reference to the right side of the register panel. At the center of the turntable, defining the inner margin of the conveying area [R. 224]. The arm is of substantial width, so that this rounded end is of substantial circumference, and so that the groceries will not pile up in back of the arm [R. 223].

The guiding edge of the arm 17 is disposed approximately four inches off center (leftward of a radius of the turntable extending down the center of the arm) [R. 224].

Leftward of the rear end of guide arm 17 is an outlet throat 2.

A bagging platform or counter 14, 15 is located rearwardly of the throat 2, being spaced therefrom by a space 1 of sufficient area to receive a weighing scale which is not sold as a part of the check stand. A hip switch 11 operates an electric motor for rotating the turntable 3.

The throat 2 does not correspond to the "discharge counter" of the patent in suit. Obviously, it is not a counter, but simply an outlet through which articles can be delivered from the turntable the same as in the throat 58 of the Bradley patent. Any article stopping on the throat 2 will be picked up by the checker and transferred on to the counter 15.

The Accused Check-A-Matic Stands Do Not Utilize a Stop for Articles on the Turntable.

The articles borne by the turntable are redirected and driven onto discharge throat 2 by the turntable in the event they are allowed to engage the guide margin of the guide arm 17. This is what occurs in the operation of the Check-A-Matic stands as admitted by plaintiff's witness Kenney [R. 61, reading as follows]:

"Q. (by Mr. Latta): Mrs. Kenney, I noticed in the operation of this check stand where there were a number of articles in a group, some of these articles came up against the side of the register support panel here and as the turntable continued to rotate, these articles were feeding towards you along the edge of the panel. That did actually happen in this demonstration of yours, did it not? A. I imagine it did.

Q. Isn't that a customary operation in this type of checkstand for the articles to feed along the side

of the register as the turntable revolves? A. Yes, it is, with a good load."

The witness Sellers explained in detail how the articles, moving in a circular path on the turntable, will meet a loading edge of the guide member with an angle of approach less than 90° , as indicated by the straight arrow in Check-A-Matic Exhibit E-7 [R. 314], the magnitude of this angle of approach being indicated by the short arcuate double headed arrow [R. 199], results in the movement of the articles being redirected out to the discharge throat, and thus there is a basic difference between the operation of the Check-A-Matic stand and the stand of the George Patent in suit [R. 200, 222, reading as follows]:

"A. Yes, it is that difference in the angle and in the slope of the guide * * * which brings about a difference in results. In George, the result is the stopping of the movement of the article, whereas in the Check-A-Matic construction, the movement is merely redirected.

Q. What is the operation of the check stand in each of these instances as an article is rotated by the turntable and contacts the guiding edge, which we see here in the model C-3 as the left edge of the support panel for the register? A. Well, as the table rotates and it hits the guide arm, the merchandise comes down through the throat to the checker.

Q. Is it driven into the throat by the rotation of the turntable? A. The combination of the rotation of the turntable and the angle of the guide.

Q. Do you also find that operation and the corresponding guide member in the FD-5? A. Yes."

The Guide Arm of the FD-5 Is Not a Register Support.

The register support panel is at a higher level than the guide arm 17, and while the panel at its leftward corner is supported upon the rear end of the guide arm, the cash register, shown in broken lines in the lower figure of Exhibit C, extends out into midair over the guide arm and the turntable and engages only the supporting panel. The projecting area of the register bottom is only approximately 25% thereof and between 60% and 85% of the bottom of the register is in supported contact with the support panel when the register is properly installed with its right rear corner filling the right rear corner of the support panel (which is the position that the Check-A-Matic Company designates to the purchaser) [R. 224, 225].

The register is thus solidly supported against tipping [R. 204, 205].

Even when the supported area is only 60%, the register is stably supported [R. 226].

Appellants have gone to great length in developing a record to show that store owners upon occasion insert blocks of wood etc., beneath the forward corner of the register and the guide arm in order to add support for the register. This has occurred through the individual initiative of store owners who for some reason may prefer to move the register as much as five inches leftward from its proper position lined up with the right margin of the support panel, and in some cases moving the register to that extent both leftward and rearwardly (toward the front of the check stand). It is thus obviously possible to so reduce the supported area as to leave the register in an unstable, tilting condition on the panel. But the

instructions of the Check-A-Matic Company are to place the register with the right rear corner filling the right rear corner of the panel [R. 224]; and it is never suggested to a market owner that he block up the inner corner of the register [R. 225]. In contrast to the two isolated instances shown by appellant, the witness Thompson, in charge of sales in the San Francisco area, had the registers in all of his check stands in that area installed properly and had not seen any of them moved [R. 225].

No instance of displacing the register was shown to have occurred elsewhere (than Corona Del Mar and Carlsbad) either in Los Angeles County or in Northern California although the witness Alvarado testified [R. 71] that he had seen Check-A-Matic stands with the registers properly aligned with the right and front panel margins; and had looked at very many Check-A-Matic stands in Los Angeles County. There is no evidence in the record that any Check-A-Matic official ever suggested or acquiesced in any such displacement and blocking practice.

Claim 3 Is Not Infringed by the FD-5.

Referring now to appellant's chart (page VI of Appendix to App. Br.), which, it is said, illustrates the alleged infringement of claim 3, and using appellant's reference letters thereon, infringement is avoided in the following particulars:

A. The register support panel does not have a stop portion along one edge thereof. The legend referring to the support panel in this chart is directed by its lead line to the wrong part, *i.e.*, the guide arm, rather than to the shaded triangular register support panel. Furthermore, the edge of the guide arm does not constitute a stop portion as has been pointed out.

B. The turntable does not rotate partially underneath the register support panel, which, as pointed out, lies outside the area of the turntable.

**Claim 5 of the George Patent Is Not Infringed by the FD-5.
(Appellant's Chart VII)**

D. The register panel is not supported above a quadrant of the turntable, nor does the turntable rotate underneath the support panel. Here again the lead line from the legend relating to this feature points to the wrong part, the guide arm rather than the register panel, which is not labeled.

C. As pointed out, the counter in the FD-5 is the part designated 14, 15 and not the small area discharge throat between the turntable and the scale well. The lead line from the legend concerning the discharge counter points to the wrong part. The counter 14, 15 does not extend as a continuation from the periphery of the turntable. The scale well intervenes.

Claim 6 (Appellant's Chart VIII) Is Avoided by the FD-5.

D. The legend pointing to the guide arm and labelled "stop" is improperly applied, since the guide arm is not a stop but a movement directing guide.

C. The counter 14, 15 does not have a portion thereof conformed to a segment of the turntable. The discharge throat, which is conformed to the periphery of the turntable in accordance with the prior art, is not the "discharge counter" of the patent.

Claim 7 (Chart IX) Is Avoided by the FD-5 in the Following Particulars:

C. The register support, the triangular shaded area, is not positioned over a sector of the receiving counter, but entirely outside the area of the counter as pointed out. The

lead line from this legend points to the wrong part, namely the guide arm which, furthermore, does not constitute a stop, as pointed out.

D. The counter 14, 15, does not extend as an extension of the receiving counter (turntable) adjacent a stop. It is spaced a substantial distance away from the turntable. The legend on this feature is applied to the wrong part, namely the discharge throat which is not the counter.

The Check-A-Matic Model C-3 Does Not Infringe the Patent in Suit.

This check stand, which preceded the FD-5, differs therefrom primarily in that the register support panel [Pltf. Ex. 32, R. 300] does extend over roughly a quadrant of the turntable, and the merchandise guide constitutes the left margin of this panel as faced by the checker. Actually, the panel covers substantially more than a quadrant of the turntable, its rounded acute corner being rounded on a radius approximately corresponding to the radius of rounding of the inner end of the guide arm of the FD-5, and its margin being disposed at approximately the same angle with reference to a radius as in the case of the guide arm of the FD-5, so that articles contacting this leftward guide edge of the panel will not be stopped but will be redirected and moved by the turntable off of its periphery and onto the narrow discharge throat shown at 2. This is the check stand that was demonstrated before the trial court.

This difference in functioning of the guide edge of the register panel in the C-3 as contrasted to the stopping function of the guide edge of the panel of the George patent, is brought out in the preceding discussion of the FD-5, and will not be further discussed at this point.

Claim 3 (Chart II) Is Avoided by the C-3, as Follows:

A. The register support panel does not have a stop portion along one edge thereof.

B. Articles on the turntable are not rotated against a stop portion.

C. The discharge counter does not extend from the turntable adjacent the support panel (see corresponding feature in discussion of the FD-5 in relation to this claim).

D. It is not the end of the discharge counter that extends arcuately along the periphery of the turntable.

Claim 6 (Chart IV) Is Avoided by the C-3, as Follows:

D. The leftward margin of the register panel is not a stop, as pointed out.

C. The discharge throat is not a counter. The counter 15 is not conformed to a segment of the turntable so as to permit articles to be slid from the table onto the counter.

Claim 7 (Chart V) Is Avoided by the C-3 as Follows:

C. The register support does not have a side edge forming an article stop.

D. The discharge throat is not a counter. The counter 15 is not an extension of the turntable nor is it adjacent a stop.

The Check-A-Matic Stands Utilize a Different Concept of Operation.

Alleged error No. 6—that the trial court failed to take into account the allegedly admitted fact that the accused devices utilize the same concept of operation as the patented device for the same purpose.

From the foregoing analysis, it is apparent that the Check-A-Matic FD-5 and C-3 check stands do not utilize the same concept of operation as the patented device. In contrast to George's concept of moving the articles against a recessed side edge of the register support and positively stopping them, at a position of maximum closeness to the side of the register, the accused check stands revert to the teaching of the prior art as exemplified by the Price patent and provide for merely redirecting the movement of the articles from a circular path into a movement toward and off the periphery of the turntable, without stopping.

Appellant's own witness McNeil [R. 78] testifying concerning the C-3, stated:

"Q. The margin of the panel does not actually stop the articles from moving out past the periphery of the disc. does it? A. No, it stops them from going onto the register, but not from going to the discharge counter."

File History Refutes Contention That George Claims Are Broad Enough to Dominate the Check-A-Matic Operation of Redirecting.

This is a contrary mode of operation to that of the check stand of the patent in suit. George, in avoiding repeated rejections by the Examiner in the Patent Office, based on the Bradley patent, insisted that his invention was characterized by the arrangement in which his rotary conveyor will "*positively bring all articles to a stop alongside the cash register*". Having obtained allowance of his claims on the basis of this representation, George (and his successors) can not now contend for a broader interpretation of his claims.

Claim 5 of the Patent in Suit Is Not Infringed by the C-3.

Claim 5 Is Restricted by File Wrapper Estoppel.

Claim 5 of the patent in suit distinguishes from claim 12 of the original application in one respect, namely, in specifying *that the register support panel is adjacent to the discharge counter*. Claim 12, omitting this limitation, was rejected as being unpatentable over the Bradley patent taken with the Wilcox and Price patents. In this rejection (the Examiner's action of July 21, 1950, page 3, last three lines) the *Examiner held that no invention would be involved in replacing the belt conveyor of Bradley by a rotary turntable conveyor as suggested by Price and Wilcox*. The applicant George then cancelled claim 12 and retained claim 5, containing the limitation noted above, *relating to the adjacency of the register support to the discharge counter*. Thus claim 5 cannot be construed as being infringed by the Check-A-Matic C-3 and FD-5 check stands, in which the register stand is not adjacent to the discharge counter, since the full width of the scale well intervenes between the register support and the discharge counter.

Where the Defendant's Machine Embodies an Essential Operating Part That Operates on a Different Principle From the Allegedly Corresponding Part of the Patent in Suit, Such Operating Part Cannot Be Regarded as the Mechanical Equivalent of the Part in the Patent.

Wire Tie Machinery Company et al. v. Pacific Box Corporation Ltd. (C. C. A. 9, 1939), 43 U. S. P. Q. 128;

Kemart Corp. v. Printing Arts Research Laboratories (C. A. 9, 1953), 96 U. S. P. Q. 159.

In the *Wire Tie Machinery* case the Court said:

“The argument seems to be that the claims of '259 were broad enough to cover any means of encircling a tensioned binding wire about an object to be bound and tied, and means for securing the wires in a substantially flat joint.”

The Court proceeded to hold that the ring gear of the defendant's device was not the mechanical equivalent of the revolving arm of the patent in suit, and further commented:

“Appellant cannot be permitted to construe his claims with reference to his drawings and specifications in order to escape invalidity, and then in the next breath seek to disregard the drawings and specifications in order to start infringement.”

These Cases Hold That This Rule Applies Even Where the Defendants' Device or Process Falls Within the Literal Term of the Claims of the Patent in Suit.

In the *Kemart* case, this Court stated:

“the fact that the claims of the Marks patent are broad enough to cover appellant's process does not establish infringement. The claims are to be read in connection with the specifications, and a patentee's broadest claim can be no broader than his actual invention.”

In *Goodman v. Supermold* (C. A. 9), 41 U. S. P. Q. 188, the patent in suit described and showed a tire mold having two annular rings for pressing against respective sides of the tire, but claim 12 of that patent specified only a single ring. This Court found

“The mode of operation of the apparatus according to the specifications depends upon the combina-

tion with a ring on each side of the tire. The patent does not teach the use of a single ring pressing against only one side of the tire, and such use cannot be claimed. [R. S. 4888].”

In its summary, the Court held that this claim was invalid for incompleteness.

The C-2 Stand.

The C-2 check stand, of which one or two were made, is referred to intermittently in the records along with the C-3. The appellant states that the C-2 had a leftward edge extending on a true radius of the turntable, but there is no evidence in the record to substantiate this, and counsel is not so advised that this was the case. Since it was the burden of appellant to establish proof of the C-2, which burden has not been sustained, there is no basis for a ruling as to the C-2.

Conclusion.

In conclusion, it is submitted:

A. The patent in suit is invalid:

1. For overclaiming the aggregational assembly of old discharge counter and old turntable in the old combination of conveyor, register stand and discharge counter.

2. For lack of invention in the bringing together of these old components in the old assembly shown by Bradley.

B. The patent is narrow and restricted, the accused Check-A-Matic stands do not utilize the same arrange-

ment of parts nor the same mode of operation, and accordingly, none of them infringe.

The Court is respectfully requested to affirm the decision of the District Court in this case and to render a decision determining the lack of infringement in the accused Check-A-Matic stands.

Respectfully submitted,

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M. Gross, individually and doing business as
Check-A-Matic Co., Appellees.*

